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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,868	10/24/2005	Takeshi Koda	8048-1105	2144

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EXAMINER	
ADEGEYE, OLUWASEUN	

ART UNIT	PAPER NUMBER
2481	

NOTIFICATION DATE	DELIVERY MODE
11/16/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary	Application No. 10/529,868	Applicant(s) KODA ET AL.	
	Examiner OLUWASEUN A. ADEGEYE	Art Unit 2481	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/26/2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 2, 8, 12, 14, 16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 2, 8, 12, 14, 16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04/01/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 12, 14, 16 and 18 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 - 2, 8, 14, 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Said claims disclose "an information record medium" (line 1). Both said claim and the respective specification (page 32) fail to disclose whether said "information record medium" is limited to a non-transitory medium or transitory propagating signal. Reading said claim under the broadest reasonable interpretation "information record medium" is considered to read on a transitory propagating signal. See the Subject Matter Eligibility of Computer Readable Media memo dated February, 23 2010 (1351 OG 212). A claim directed to only signals per se is not a process, machine, manufacture, or composition of matter and therefore is not directed to statutory subject matter. See MPEP § 2106. Thus, both said claim and said specification fail to define said "information record medium" to be statutory media.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 2, 8, 12, 14, 16, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ninomiya (US 2002/0090197 A1) in view of Roth et al (US 7,343,052 B2).

As to **claim 1**, Ninomiya discloses an information record medium (see [047].“....Specifically the optical disc is assumed to be a DVD-RAM.....”) on which there are recorded:

an object data file (VOBUs) for storing, by a unit of packet, object data which includes (a) a main stream including video information to indicate a main-video (see [049].“...The pack sequence will then be grouped into several VOBUs (video object units).....”) and

a play list information file (PLI) (see [059].“...The PGCI table includes a plurality pieces of Playlist information.....”) for storing play list information which defines, by a unit of item, IN-point information to indicate a reproduction start time of the object data and OUT-point information to indicate a reproduction end time of the object data (see [060].“...., the beginning of the reproduction section (In point) and the ending thereof (Out point) are specified....”). (The above cited paragraph and fig. 3 discloses cell information which is a part of the playlist information. The Cell information contains the

IN point and the OUT point); and

an object information file (TMAPI) for storing object information which includes an address of the object data, which is specified by the IN-point information and the OUT point information, corresponding to each item (see [106].”The address time code conversion unit 7 specifies according to the time code, addresses of VOBUS inside the AV file.)

each of the object data file, the play list information file and the object information file is recorded into a different area respectively (see fig. 3. From the above cited figure it is clear that the object data file (VOBUs), play list information file (PLI) and the object information file TMAPI) .

Ninomiya does not disclose (b) a sub stream including a plurality of button information to indicate a plurality of buttons displayable at least partially over the main-video and to function as a button in the sub stream;

at least one of the plurality of button information includes normal button information for defining a normal display control for displaying the button in a normal state in which the button is not selected and executed displaying a normal state button, selected button information for defining a selected display control for displaying the button in a selected state in which the button is selected displaying a selected state button, and activated button information for defining an activated display control for displaying the button in an activated state in which the button is activated.

Roth discloses (b) a sub stream including a plurality of button information to indicate a plurality of buttons displayable at least partially over the main-video and to function as a button in the sub stream; (see column 5, lines 39 – 43.”..In step 301, the method creates logical data (button highlight information) defining a set of (in the 3x3 example) nine button “hot spots” on the full view still image.....”)

at least one of the plurality of button information includes normal button information for defining a normal display control for displaying the button in a normal state in which the button is not selected (see column 5, lines 47 – 51. “.... The overlay is set to be transparent when within the area of a button that is in the normal (unselected state).....”) and executed displaying a normal state button, selected button information for defining a selected display control for displaying the button in a selected state in which the button is selected displaying a selected state button(see column 5, lines 47 – 51. “.... The overlay is set to be transparent when within the area of a button that is in the normal (unselected state), and to be visible (not fully transparent) within the area of a button that is selected or activated.....”), and activated button information for defining an activated display control for displaying the button in an activated state in which the button is activated (see column 5, lines 47 – 51. “.... The overlay is set to be transparent when within the area of a button that is in the normal (unselected state), and to be visible (not fully transparent) within the area of a button that is selected or activated.....”).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added the sub stream including a plurality of button information as taught by Roth to the apparatus of Ninomiya to arrive at a system that is capable of generating logical data (button information) required to allow navigation of the generated files by end-users (see column 3, lines 1 - 5).

As to **claim 2**, Ninomiya in view of Roth discloses the information record medium according to claim 1. Ninomiya does not disclose wherein the button information defines an opaque video part in a rectangular area placed in the sub-stream.

Roth discloses wherein the button information defines an opaque video part in a rectangular area placed in the sub- stream (see column 5, lines 39 – 43. "...In step 301, the method creates logical data (button highlight information) defining a set of (in the 3x3 example) nine button "hot spots" on the full view still image....."). Also see column 5, lines 29 – 38."...Step 211 encodes each of the nine zoom sequences and 24 pan sequences into"). See Motivation from claim 1 above.

As to **claim 8**, Ninomiya in view of Roth discloses the information record medium according to claim 1. Ninomiya does not disclose wherein the button information further defines a button command to be executed if the button is operated.

Roth discloses wherein the button information further defines a button command to be executed if the button is operated (see column 5, lines 47 – 51. “.... The overlay is set to be transparent when within the area of a button that is in the normal (unselected state), and to be visible (not fully transparent) within the area of a button that is selected or activated.....”). Column 5, lines 40 – 42 discloses creating logical data defining each button. See Motivation from claim 1 above.

As to **claim 12** this is an apparatus claim corresponding to the method claim 1. Therefore, claim 12 is analyzed and rejected as previously discussed with respect to claim 1. A first , second and third record device for recording an object data file , a play list file and an object information file is the system control unit 1 (see [098] and fig. 13)

As to **claim 14**, grounds for rejecting claim 1 apply to claim 14 in its entirety.

As to **claim 16** this is an apparatus claim corresponding to the method claim 1. Therefore, claim 16 is analyzed and rejected as previously discussed with respect to claim 1. Ninomiya discloses a reading device (disc drive 2) (see fig. 13 and [101] and [102]). Roth discloses a display output device and control device for controlling the display output device (see column 5, lines 52 – 57) .Column 5, lines 43 – 47 also discloses a screen that displays the buttons.

As to **claim 18**, grounds for rejecting claim 16 apply to claim 18 in its entirety.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUWASEUN A. ADEGEYE whose telephone number is (571)270-1711. The examiner can normally be reached on Monday - Friday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter-Anthony Pappas can be reached on 571-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

11/03/2010
/O.A./

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/Peter-Anthony Pappas/

Supervisory Patent Examiner, Art Unit 2481